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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,304	03/21/2001	Robert A. Miller	10004450-1	4826

7590 07/14/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,304

Applicant(s)

MILLER, ROBERT A.

Examiner

Doug Hutton

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11252002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Applicant is advised that should Claims 2-5 be found allowable, Claims 7-10, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 7-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mercer, U.S. Patent No. 6,547,830.

Claim 1:

Mercer discloses, in a system for creating documents from processed data, an apparatus for forming processed data (see Figures 1-8; see Column 1, Line 1 through Column 12, Line 21), comprising:

- a data storage device for storing the processed data (the text display system discloses a "data storage device for storing the processed data" in that it retrieves a web page from the Internet);
- a form engine connected to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules (the text display system discloses a "form engine connected to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules" in that it includes software that comprises rules to revise the web page format in order to maximize the amount of text viewable on the output device display); and
- an output device connected to said form engine for outputting formatted data created from said form engine (the text display system discloses an "output device connected to said form engine for outputting formatted data created from said form engine" in that it includes an output device that displays the web page in the revised format).

Claim 2:

Mercer discloses the apparatus of Claim 1, wherein said predetermined high level rules use loose value tradeoffs for formatting processed data (the text display system discloses "predetermined high level rules that use loose value tradeoffs for formatting processed data" in that it retrieves a web page from the Internet that will not fit onto a small display and fits the web page data onto one page of the display; the text display system also "cleanly defines text columns," as indicated in the cited text).

Claim 3:

Mercer discloses the apparatus of Claim 2, wherein said loose value tradeoffs are selected from a group including: fit all data on one page; cleanly define text columns; bold face first line of new text; and shrink photos proportionally with text (as indicated in the above rejection for Claim 2, the text display system discloses "fitting all data on one page" and "cleanly defining text columns").

Claim 4:

Mercer discloses the apparatus of Claim 2, further comprising sublevels of loose value tradeoffs (the text display system discloses "sublevels of loose value tradeoffs" in that it discloses "reducing font" and "reducing length of some data fields" of the retrieved web page, as indicated in the cited text).

Claim 5:

Mercer discloses the apparatus of Claim 3, wherein loose value tradeoff -fit all data on one page- further includes sublevel loose value trade offs: reduce font, shrink photos and graphics proportional with font, reduce length of some data fields, and shrink margin (as indicated in the above rejection for Claim 4, the text display system discloses "reducing font" and "reducing length of some data fields" of the retrieved web page).

Claims 7-10:

As indicated in the above rejections for Claims 2-5, Mercer discloses every limitation of Claims 7-10, respectively.

Claims 11-15:

These claims recite merely a method performed by the apparatus described in Claims 1-5. Thus, Mercer discloses every limitation of Claims 11-15 using the same rationale in the rejections for Claims 1-5, respectively.

Claims 16-20:

These claims recite merely computer software for the apparatus described in Claims 1-5. Thus, Mercer discloses every limitation of Claims 16-20 using the same rationale in the rejections for Claims 1-5, respectively.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kojima, U.S. Patent No. 6,633,401.

Claim 1:

Kojima discloses, in a system for creating documents from processed data, an apparatus for forming processed data (see Figures 1-10; see Column 1, Line 1 through Column 16, Line 51), comprising:

- a data storage device for storing the processed data (the image forming system discloses a “data storage device for storing the processed data” in that it retrieves email and facsimile messages from external sources);
- a form engine connected to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules (the image forming system discloses a “form engine connected to said data storage device for formatting the processed data in said data storage device in accordance with predetermined high level rules” in that it comprises rules to revise the format of the email and facsimile messages in order to save printer paper); and
- an output device connected to said form engine for outputting formatted data created from said form engine (the text display system discloses an “output device connected to said form engine for outputting formatted data created from said form engine” in that it includes a printer).

Claim 2:

Kojima discloses the apparatus of Claim 1, wherein said predetermined high level rules use loose value tradeoffs for formatting processed data (the image forming system discloses "predetermined high level rules that use loose value tradeoffs for formatting processed data" in that it retrieves email and facsimile messages that are printed on multiple pages and fits them onto a single page).

Claim 3:

Kojima discloses the apparatus of Claim 2, wherein said loose value tradeoffs are selected from a group including: fit all data on one page; cleanly define text columns; bold face first line of new text; and shrink photos proportionally with text (as indicated in the above rejection for Claim 2, the image forming system discloses "fitting all data on one page").

Claim 4:

Kojima discloses the apparatus of Claim 2, further comprising sublevels of loose value tradeoffs (the image forming system discloses "sublevels of loose value tradeoffs" in that it discloses "reducing font" and "reducing length of some data fields" of the retrieved web page, as indicated in the cited text).

Claim 5:

Kojima discloses the apparatus of Claim 3, wherein loose value tradeoff -fit all data on one page- further includes sublevel loose value trade offs: reduce font, shrink photos and graphics proportional with font, reduce length of some data fields, and shrink margin (as indicated in the above rejection for Claim 4, the image forming system discloses "reducing font" and "reducing length of some data fields" of the retrieved web page).

Claim 6:

Kojima discloses the apparatus of Claim 1, wherein the output device is a printer (as indicated in the above rejection for Claim 1, the image forming system discloses a printer).

Claims 7-10:

As indicated in the above rejections for Claims 2-5, Kojima discloses every limitation of Claims 7-10, respectively.

Claims 11-15:

These claims recite merely a method performed by the apparatus described in Claims 1-5. Thus, Kojima discloses every limitation of Claims 11-15 using the same rationale in the rejections for Claims 1-5, respectively.

Claims 16-20:

These claims recite merely computer software for the apparatus described in Claims 1-5. Thus, Kojima discloses every limitation of Claims 16-20 using the same rationale in the rejections for Claims 1-5, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer, U.S. Patent No. 6,547,830, in view of Schilit et al., U.S. Patent No. 6,670,968.

Claim 6:

As indicated in the above discussion, Mercer discloses every element of Claim 1.

Mercer fails to expressly disclose an output device that is a printer.

Schilit teaches a text display system that retrieves a web page using a cellular telephone and prints the web page on a printer (see Figures 1-7; see Column 1, Line 1 through Column 12, Line 58) for the purpose of obtaining a hard copy of the retrieved web page.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the text display system, disclosed in Mercer,

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to include an output device that is a printer for the purpose of obtaining a hard copy of the retrieved web page, as taught by Schilit.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kumakawa, U.S. Patent No. 5,425,138; Bubie et al., U.S. Patent No. 6,453,078; and Gabbe et al., U.S. Patent No. 4,928,252.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
July 6, 2004


HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100